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EXAMINER

TRAN, MAI T

ART UNIT PAPER NUMBER

2129

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/748,970		RAMAMURTHY ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Mai T. Tran		2129	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/30/2003 & 07/02/2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

This Office Action is responsive to application 10/748970, filed December 30, 2003.

Claims 1-39 are presented for examination.

### DRAWINGS

The drawings are objected to because of the minor informalities:

- the set of replacement drawings submitted by applicants during the response to the Notice to File Missing Parts is incomplete. Figure 18 is missing.
- Figure 4:
  - ❖ The spelling of the content 130 and 132 “cataloged, semi-cataloged, and un-cataloged” is different with the specification on page 15, line 9.
  - ❖ Reference character 140 “Process Development Platform” is different with the specification on page 16, line 17.
  - ❖ Reference character 142 “Process Remote Capture” is different with the specification on page 16, lines 18-19.
  - ❖ Reference character 144 “Process Analyzer” is different with the specification on page 16, line 20.
  - ❖ Reference character 146 “Process Generator” has documentation and “Elearning”. Elearning is spelled differently with the specification on page 16, line 21.
  - ❖ Reference character 148 “Process Benchmark and Intelligence” is different with the specification on page 16, line 22, has Benchmark portion is also different with the specification on page 16 line 23.
- Figure 5A:
  - ❖ Reference character “194” Manual Process is different with the specification on page 18, line 25.
  - ❖ Reference character 194d: the question should be “May I help you?”
  - ❖ Reference character 194c under 194d should be 194e.
  - ❖ Reference character 194f should be “Thanks customer” as in the specification on page 19, line 10.
- Figure 6:

- ❖ Reference character 202: Capture Events and “Image” should be Images as in the specification on page 19, line 17.
- ❖ Reference character 204: image should be spelled images as in the specification on page 19, line 18.
- ❖ Reference character 206: image should be spelled images.
- Figure 7:
  - ❖ Reference character 216: “Catalogued Process” is spelled differently with the specification on page 20, line 4.
- Figure 10:
  - ❖ Reference character 272: “Catalog Uncatalogued process” is spelled differently with the specification on page 22, line 21.
  - ❖ Reference character 278: the arrow, that points to character number 270 “Analyzer”, is labeled “Performance estimates” which is different with the specification on page 22, line 23.
- Figure 12:
  - ❖ Information on one of the applications in this capture is listed in the following order in the drawings: TAPName, TAPVersion, TAPPath, TAPExeName, which is different with the specification on page 24, line 25 and page 25, lines 1-3.
- Figure 13:
  - ❖ Region of the control is listed in the following order in the drawings: left, top, right, bottom, which is different with the specification on page 25, line 16.
- Figure 15:
  - ❖ Reference character 314: the spelling of “process to create” in the rectangular box is incorrect.
  - ❖ Reference character 316: the spelling of “finetune” in the rectangular box is incorrect.
- Figure 17:
  - ❖ Reference character 334: “To Be processes” is different with the specification on page 28, line 18.

Applicants are suggested to be consistent with the naming and spelling of reference characters numbers through out the drawings and the specification.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because:

- Figure 5:
  - ❖ Reference characters "172" and "178" have both been used to designate Security Definitions.
- Figure 8:
  - ❖ Reference characters "232" and "244" have both been used to designate Linear Process.
  - ❖ Reference characters "234" and "250" have both been used to designate Decision Trees and Rule Engine.

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- ❖ Reference characters "236" and "251" have both been used to designate Manual Process.
- ❖ Reference characters "240" and "246" have both been used to designate Steps.
- ❖ Reference characters "242" and "248" have both been used to designate Hierarchy.

- Figure 10:

- ❖ Reference characters "292" and "294" have both been used to designate XML DB.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

- "Manual flows 252" is not in Figure 8.
- "276" is not in Figure 10.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of

an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### **SPECIFICATION**

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The disclosure is objected to because of the numerous informalities. The following is a non-exhaustive list of examples:

1. On page 7, line 28, the words "cataloging", "cataloged" are spelled differently than in other paragraphs (i.e. page 15, line 9, line 21, line 24, and line 27, page 18, line 14, line 16, page 22, line 18, line 21 etc...) of the specification. Applicants need to be consistent.
2. On page 10, line 5 please add (KPS) after a knowledge provisioning system.
3. On page 11, line 10, reference character "82" has been used to designate both "Track and Inspect" step and "Webserver for Users" step.
4. On page 12:
  - Line 8, applicants need to spell out "UI" control, also a period is necessary at the end of the sentence.
  - Lines 14-15, the phrase "with activate one or more" does not make sense.

5. On page 14, line 15, the phrase “by make the change or whether the goals” is grammatically incorrect.
6. On page 16, lines 24-25, reference characters “126” and “128” have both been used to designate “the integration bus”.
7. On page 17, line 2, “process models 158”, “applications 160”, and “interfaces 162” need to match with the drawings of Figure 4.
8. On page 18, lines 24-25, reference characters “194” and “194a” have both been used to designate “Manual Process”.
9. On page 21:
  - Line 11, line 14, “a rules engine” is spelled incorrectly.
  - Line 15, “performs a analysis” is grammatically incorrect.
  - Line 16, “performs and analysis” is grammatically incorrect.
10. On page 22, line 2, WYSIWIG does not match with “**What You See Is What You Get**”).
11. On page 26:
  - Line 20, “Application to be captures” is grammatically incorrect.
  - Line 21, “Applications that should not b captured” is grammatically incorrect.
12. On page 27, line 2 “generates the process mode at 314” is incorrect.
13. On page 28, line 28, “after training as give” is grammatically incorrect.
14. On page 33, lines 15-16, “that it can envelope” is grammatically incorrect.
15. On page 34, line 19, “WYSIWIG” is incorrect.



Appropriate correction is required.

### CLAIM OBJECTIONS

Claim **33** is objected to because of the following informalities: claim 33 is a system claim and depends on claim 13, which is a method claim. Examiner believes this is a typo, if not applicants need to clarify. Appropriate correction is required.

### CLAIM REJECTIONS - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The invention as disclosed in claims **1-39** is directed to non-statutory subject matter.

2. None of the claims is limited to practical applications in the technological arts. Examiner finds that *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994) controls the 35 U.S.C. § 101 issues on that point for reasons made clear by the Federal Circuit in *AT&T Corp. v. Excel Communications, Inc.*, 50 USPQ2d 1447 (Fed. Cir. 1999).

Specially, the Federal Circuit held that the act of:

...[T]aking several abstract ideas and manipulating them together adds nothing to the basic equation. *AT&T v. Excel* at 1453 quoting *In re Warmerdam*, 33 F.3d 1354, 1360 (Fed. Cir. 1994).

Examiner finds that Applicants' "modeling a process, process capture" references are just such abstract ideas.

3. Examiner bases his position upon guidance provided by the Federal Circuit in *In re Warmerdam*, as interpreted by *AT&T v. Excel*. This set of precedents is within the same

line of cases as the *Alappat-State Street Bank* decisions and is in complete agreement with those decisions. *Warmerdam* is consistent with *State Street*'s holding that:

Today we hold that *the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price*, constitutes a practical application of a mathematical algorithm, formula, or calculation because it produces 'a useful, concrete and tangible result' -- *a final share price momentarily fixed for recording purposes and even accepted and relied upon by regulatory authorities and in subsequent trades*. (emphasis added) *State Street Bank* at 1601.

4. True enough, that case later eliminated the "business method exception" in order to show that business methods were not per se nonstatutory, but the court clearly *did not* go so far as to make business methods *per se* statutory. A plain reading of the excerpt above shows that the Court was *very specific* in its definition of the new *practical application*. It would have been much easier for the court to say that "business methods were per se statutory" than it was to define the practical application in the case as "...the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price..."
5. The court was being very specific.
6. Additionally, the court was also careful to specify that the "useful, concrete and tangible result" it found was "a final share price momentarily fixed for recording purposes and even accepted and relied upon by regulatory authorities and in subsequent trades." (i.e. the trading activity is the further practical use of the real world monetary data beyond the transformation in the computer – i.e., "post-processing activity").
7. Applicants cite no such specific results to define a useful, concrete and tangible result. Neither do Applicants specify the associated practical application with the kind of specificity the Federal Circuit used.
8. Furthermore, in the case *In re Warmerdam*, the Federal Circuit held that:

...[T]he dispositive issue for assessing compliance with Section 101 in this case is whether the claim is for a process that goes beyond simply manipulating 'abstract ideas' or 'natural phenomena' ... As the Supreme Court has made clear, '[a]n idea of itself is not patentable, ... taking several abstract ideas and manipulating them together adds nothing to the basic equation'. In re Warmerdam 31 USPQ2d at 1759 (emphasis added).

9. Since the Federal Circuit held in *Warmerdam* that this is the “dispositive issue” when it judged the usefulness, concreteness, and tangibility of the claim limitations in that case, Examiner in the present case views this holding as the dispositive issue for determining whether a claim is “useful, concrete, and tangible” in similar cases. Accordingly, the Examiner finds that Applicants manipulated a set of abstract “modeling a process, process capture, user’s interactions with a computer” to solve purely algorithmic problems in the abstract [i.e. what *kind* of “process” to be modeled”? (mental process i.e. process of thinking?), what *kind* of “user’s interactions with a computer” is used? (algorithm elements? eyes movement of a user? user’s heart rhythm?)]. Clearly, a claim for manipulation of “modeling a process, process capture, capturing user’s interactions with a computer” is provably even more abstract (and thereby less limited in practical application) than pure “mathematical algorithms” which the Supreme Court has held are per se nonstatutory – in fact, it *includes* the expression of nonstatutory mathematical algorithms.
10. Since the claims are not limited to exclude such abstractions, the broadest reasonable interpretation of the claim limitations includes such abstractions. Therefore, the claims are impermissibly abstract under 35 U.S.C. §101 doctrine.

11. Since *Warmerdam* is within the *Alappat-State Street Bank* line of cases, it takes the same view of “useful, concrete, and tangible” the Federal Circuit applied in *State Street Bank*. Therefore, under *State Street Bank*, this could not be a “useful, concrete and tangible result”. There is only manipulation of abstract ideas.
12. The Federal Circuit validated the use of *Warmerdam* in its more recent *AT&T Corp. v. Excel Communications, Inc.* decision. The Court reminded us that:

Finally, **the decision in *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994) is not to the contrary.** \*\*\* The court found that the claimed process did nothing more than manipulate basic mathematical constructs and concluded that ‘taking several abstract ideas and manipulating them together adds nothing to the basic equation’; hence, the court held that the claims were properly rejected under §101 ... Whether one agrees with the court’s conclusion on the facts, the holding of the case is a straightforward application of the basic principle that mere laws of nature, natural phenomena, and abstract ideas are not within the categories of inventions or discoveries that may be patented under §101. (emphasis added) *AT&T Corp. v. Excel Communications, Inc.*, 50 USPQ2d 1447, 1453 (Fed. Cir. 1999).

13. Remember that in *In re Warmerdam*, the Court said that this was the dispositive issue to be considered. In the *AT&T* decision cited above, the Court reaffirms that this is the issue for assessing the “useful, concrete, and tangible” nature of a set of claims under 101 doctrine. Accordingly, Examiner views the *Warmerdam* holding as the dispositive issue in this analogous case.
14. The fact that the invention is merely the manipulation of *abstract ideas* is clear. The data referred to by Applicant’s phrase “modeling a process, process capture, user’s interactions with a computer” is simply an abstract construct that does not limit the claims to the transformation of real world data (such as monetary data or heart rhythm data) by some disclosed process. Consequently, the necessary conclusion under *AT&T*, *State Street* and *Warmerdam*, is straightforward and clear. The claims take several abstract ideas (i.e., “modeling a process, process capture, capturing user’s interactions

with a computer” in the abstract) and manipulate them together adding nothing to the basic equation. Claims 1-39 are, thereby, rejected under 35 U.S.C. §101.

### CLAIM REJECTIONS - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- Claims 1-39 are rejected under 35 U.S.C. §112, first paragraph because current case law (and accordingly, the MPEP) require such a rejection if a §101 rejection is given because when Applicant has not in fact disclosed the practical application for the invention, as a matter of law there is no way Applicant could have disclosed *how* to practice the *undisclosed* practical application. This is how the MPEP puts it:

“The how to use prong of section 112 incorporates as a matter of law the requirement of 35 U.S.C. §101 that the specification disclose as a matter of fact a practical utility for the invention.... If the application fails as a matter of fact to satisfy 35 U.S.C. §101, then the application also fails as a matter of law to enable one of ordinary skill in the art to use the invention under 35 U.S.C. §112.”; In re Kirk, 376 F.2d 936, 942, 153 USPQ 48, 53 (CCPA 1967) (“Necessarily, compliance with § 112 requires a description of how to use presently useful inventions, **otherwise an applicant would anomalously be required to teach how to use a useless invention.**”) See, MPEP 2107.01(IV), quoting In re Kirk (emphasis added).

Therefore, claims 1-39 are rejected on this basis.

- Claims 5-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 5-8 recite

the limitation "context information" which has not been described in the specification.

### **CLAIM REJECTIONS - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **1-2, 4-5, 7-13, 15-18, 20-25, 27-36, and 38-39** are rejected under 35

U.S.C. 102(b) as being anticipated by Bullwinkel et al (U. S. Patent No. 6,099,317).

#### **Claim 1**

Bullwinkel teaches a method for modeling a process, comprising the steps of:

remotely capturing actions of a user in performing the process (col. 2, lines 63-67, col. 3, lines 1-3);

storing said captured actions as captured data files (col. 5, lines 12-22);

cataloging said captured data files (col. 3, lines 11-13); and

modeling the process using said captured data files (col.5, lines 12-22).

#### **Claim 2**

Bullwinkel teaches a method of process capture, comprising the steps of:

automated remote capturing of a process performed by a user, said capturing including capture of the user's interactions with a computer (col. 2, lines 63-67, col. 3, lines 1-3);

generating captured process files of said captured process (col. 5, lines 12-22); and

storing said captured process files in a storage (col. 5, lines 12-22).

**Claim 4**

Bullwinkel teaches a method as claimed in claim 2, wherein said automated remote capturing includes capture of at least one of audio data and video data to record actions of the user in performing the process (col. 6, lines 55-65).

**Claim 5**

Bullwinkel teaches a method as claimed in claim 2, wherein said generating files includes including context information in said captured process files (col. 4, lines 61-67).

**Claim 7**

Bullwinkel teaches a method as claimed in claim 5, wherein said context information includes information from listeners reporting communications between software components and an operating system (col. 4, lines 61-67, col. 5, lines 2-6).

**Claim 8**

Bullwinkel teaches a method as claimed in claim 5, wherein said context information is derived from virtual footprints in computer software used at least in part to perform the process (col. 6, lines 60-67, col. 7, lines 1-4).

**Claim 9**

Bullwinkel teaches a method as claimed in claim 8, wherein said virtual footprints include captures of at least one of dialogs, toolbars and menus of a software application on said computer (col. 6, lines 66-67, col. 7, lines 1-4).

**Claim 10**

Bullwinkel teaches a method as claimed in claim 2, wherein said step of automated remote capture captures processes of a plurality of users (col. 2, lines 10-15, lines 30-35, lines 39-41).

**Claim 11**

Bullwinkel teaches a method as claimed in claim 10, wherein different levels of capture are provided for different ones of said plurality of users (col. 2, lines 10-15, lines 30-35, lines 39-41).

**Claim 12**

Bullwinkel teaches a method for modeling a process, comprising the steps of:  
remotely capturing actions of a user in performing the process on a computer (col. 2, lines 63-67, col. 3, lines 1-3);  
storing said captured actions as captured data files (col. 5, lines 12-22); and  
streaming the captured data files to a computer to simulate a user performing the process (col. 6, lines 32-46).

**Claim 13**

Bullwinkel teaches a method as claimed in claim 12, further comprising the steps of:  
editing said captured data files to create edited data files (col. 6, lines 32-46); and  
streaming said edited data files to a computer to simulate a user performing an edited process (col. 6, lines 32-46).



**Claim 15**

Bullwinkel teaches a method for modeling a business process in a business or organization having a plurality of computers connected to a network, comprising the steps of:

defining capture settings of users using said plurality of computers (col. 2, lines 1-44);

remotely capturing interactions with said plurality of computers according to said capture settings as capture data files (col. 2, lines 1-67); and

storing said capture data files in a repository (col. 5, lines 12-22).

**Claim 16**

Bullwinkel teaches a method as claimed in claim 15, wherein said defining includes setting different levels of capture for different ones of said plurality of computers (col. 2, lines 1-67).

**Claim 17**

Bullwinkel teaches a method as claimed in claim 16, wherein said different levels of capture are distinguished by presence of at least one of audio recording and video recording of a user's actions in performing the process (col. 6, lines 55-65).

**Claim 18**

Bullwinkel teaches a method for identifying a process, comprising the steps of:

remotely capturing actions of a user in performing the process (col. 2, lines 63-67, col. 3, lines 1-3);

storing said captured actions as captured data files (col. 5, lines 12-22); and

automatically cataloging said captured data files by pattern matching of said captured data files against a process definition (col. 3, lines 11-13, col. 10, lines 21-29).

**Claim 20**

Bullwinkel teaches a method as claimed in claim 18, wherein said cataloging includes storing ones of said captured data files as un-cataloged data files (col. 10, lines 21-29).

**Claim 21**

Bullwinkel teaches a method of process capture, comprising the steps of:

automated remote capturing of a process performed by a user, said capturing including capture of the user's interactions with a computer (col. 2, lines 63-67, col. 3, lines 1-3);

automated remote capturing of at least one of audio and video data of the process performed by the user (col. 6, lines 55-65);

generating captured process files of said captured process including flagging portions of said at least one of said audio and video data to corresponding interactions of the user with the computer (col. 5, lines 12-22); and

storing said captured process files in a storage (col. 5, lines 12-22).

**Claim 22** is the system version of method claim 1. Therefore, claim 22 is rejected under the same rationale.

**Claims 23-25, and 27-30** are the system version of method claims 2, 4, 5, 7, and 9-11.

Therefore, claims 23-25 and 27-30 are rejected under the same rationale.

**Claims 31-33** are the system version of method claims 12-14. Therefore, claims 31-33 are rejected under the same rationale.

**Claims 34-35** are the system version of method claims 15-17. Therefore, claims 34-35 are rejected under the same rationale.

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**Claims 36 and 38** are the system version of method claims 18-20. Therefore, claims 36-38 are rejected under the same rationale.

**Claim 39** is the system version of method claim 21. Therefore, claim 39 is rejected under the same rationale.

### **CLAIM REJECTIONS - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

- **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Bullwinkel as applied to claim 2 above, in view of "The Role of XML in Open Hypermedia Systems", by Jacco van Ossenbruggen et al, hereafter Van Ossenbruggen.

Bullwinkel teaches a method of process capture but fails to disclose captured process files are in XML format.

Van Ossenbruggen teaches the use of XML as a data format for structured document interchange on the Web and XML plays an important role in the development of open hypermedia systems (abstract).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the process capture method of Bullwinkel with the XML format of Van Ossenbruggen. The motivation for doing so would be to introduce hypermedia technology into as many applications and components of existing computing environments as possible and to evolve current computing environments into a world-wide, unified hypermedia environment spanning multiple computing platforms (Introduction, lines 2-5).

- **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Bullwinkel as applied to claims 2-5 above, in view of "Data Mining for Imprecise Temporal Associations", by Vincenti et al, hereafter Vincenti.

Bullwinkel teaches a method of process capture but fails to disclose inserting time stamp data captured process files.

Vincenti teaches time stamp captured events (page 2, left col., lines 1-16).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the method of modeling a process of Bullwinkel and time stamped captured process files of Vincenti. The motivation for doing so would be to obtain transactions of interest (page 2, left col., lines 1-16).

- **Claim 26** is the system version of method claim 6. Therefore, claim 26 is rejected under the same rationale.
- **Claim 14** is rejected under 35 U.S.C. 103(a) as being unpatentable over Bullwinkel as applied to claims 12-13 above, in view of “A Model Driven Methodology for “Business Process Engineering”, by Bipin Chadha, hereafter Chadha.

Bullwinkel teaches a method for modeling a process but fail to disclose captured data files constitute an as-is model, edited data files constitute a to-be model, and comparing said as-is model to said to-be model.

Chadha teaches the development of as-is and to-be model (page 3, right col., 1<sup>st</sup> paragraph, page 4, left col. 2<sup>nd</sup> paragraph).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the method for modeling a process of Bullwinkel and the development of as-is and to-be model of Chadha. The motivation for doing so would be to support an organization’s migration to effective, agile and efficient processes (page 1, right col., 2<sup>nd</sup> paragraph), and the to-be process is a radical departure from the old process where problems exist (page 1, left col., 2<sup>nd</sup> paragraph).

- **Claim 19** is rejected under 35 U.S.C. 103(a) as being unpatentable over Bullwinkel as applied to claim 18 above, in view of "Data Mining for Imprecise Temporal Associations", by Vincenti et al, hereafter Vincenti.

Bullwinkel teaches a method for identifying a process but fails to disclose applying fuzzy logic to captured data files.

Vinenti teaches fuzzy logic to classify captured data files (abstract).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the method for identifying a process of Bullwinkel with applying the fuzzy logic to captured data files of Vincenti. The motivation for doing so would be to help deal with the uncertainty of the boundaries used for classification (page 1, right column, 1<sup>st</sup> paragraph).

- **Claim 37** is the system version of method claim 19. Therefore, claim 37 is rejected under the same rationale.

## CONCLUSION

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

1. Ingoglia et al, U. S. Patent No. 5,214,780, discloses synchronized journaling system.
2. Hensley et al, U. S. Patent No. 5,333,302, discloses filtering event capture data for computer software evaluation.
3. Bowen, Robert E., U. S. Patent No. 5,442,786, discloses a method for recording user interaction with a computer database to generate reports.

4. Hart et al, U. S. Patent No. 5,546,502, discloses an automatic invocation of computational resources without user intervention.
5. Uyama, Masashi, U. S. Patent No. 5,560,011, discloses a computer system for monitoring a user's utilization pattern to determine useful tasks.
6. Hart et al, U. S. Patent No. 6,041,182, discloses an automatic invocation of computational resources without user intervention.
7. Agrawal et al, U. S. Patent No. 6,278,977, discloses deriving process models for workflow management systems from audit trails.
8. Bullwinkel et al, U. S. Patent No. 6,453,254, discloses a device that interacts with target applications.
9. Weinberg et al, U. S. Patent No. 6,587,969, discloses software system and methods for testing the functionality of a transactional server.
10. Bischof et al, US-PGPub 2004/0041827, discloses non-client-specific testing of applications.

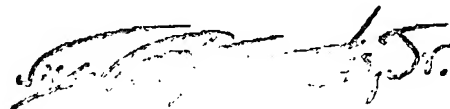
### **CORRESPONDENCE INFORMATION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mai T. Tran whose telephone number is (571) 272-4238. The examiner can normally be reached on M-F 9:00am-- 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Vincent can be reached on (571) 272-3080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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